

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/661,159

Confirmation No.: 6784

Applicant(s): Vargas

Filing Date: 12 September 2003

Title: "Shape-Transferring Cannula System
and Method of Use"

TC/Art Unit: 3736

Supplemental Petition

Date: 15 June 2010

TC Examiner: Hoekstra, J.

Petitions Examiner: Johnson, N.

Docket No.: ENDOV-001/US

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Via Electronic Filing System

Sir:

Office of Petitions Examiner Nancy Johnson has asked that Applicant submit a supplemental petition to make portions of the petition filed 24 March 2010 more legible. Accordingly, Applicant submits this supplemental petition that includes (a) the originally filed petition text and Exhibit I, and (b) portions originally filed as Exhibit I enlarged to enhance readability.

Applicant respectfully requests that this petition be granted, that the above-referenced application be revived, and that prosecution be continued in accordance with the papers filed on 24 March 2010.

Text from the originally filed petition.

Applicant respectfully petitions to withdraw a holding of abandonment, because Applicant failed to receive a Notice of Non-Compliant Amendment.

I.

The United States Patent and Trademark Office (the "Office") allegedly mailed a Notice of Non-Compliant Amendment (the "Notice") for this application on 17 November 2009. It appears that this Notice was mailed in response to Applicant's amendment document filed on 7 October 2009. As the Notice appears in the Patent Information and Retrieval System, the Notice states that the amendment document was non-compliant because the claim status identifier "Amended" should instead be "Currently Amended".

II.

In accordance with the information outlined in the Manual of Patent Examining Procedure (8th Ed. Rev. Jul. 2008), § 711.03(c), Applicant provides the following statements and information.

A. The system used to record Office actions at Intuitive Surgical, Inc. begins with the receipt of all mail addressed to the correspondence address of record associated with this application being delivered to a central mail room. There, the mail is sorted by recipient address within the company. Mail from the Office is placed in a mail receptacle for the legal department. At least once each day, a clerk in the legal department retrieves the mail from this receptacle.

Mail from the Office is first opened and examined by employee Anne Killingsworth, who functions as the legal department's docketing clerk. If a paper from the Office indicates that a response is required by a particular deadline, Anne does two things. First, she retrieves the paper file associated with the particular application and clips the paper to the outside of the file. Second, she enters the due date in the legal department's computerized docketing system record associated with the particular application. For situations that require a response be filed within one month of the paper's mailing date, Anne's general practice is to call one of the legal department's patent attorney's immediate attention to the paper. Anne prepares action due lists for all deadlines entered into the legal department's computerized docketing system, and she provides these lists to the appropriate legal department attorney.

B. The legal department uses the computerized Dennemeyer Intellectual Asset Management System (DIAMS) version 8.04.09.4, provided by Dennemeyer & Co., to record due dates associated with papers received from the Office. This is a reliable system. Entry data for each patent application includes the Office's application number, the corresponding attorney docket number, and the due date for any response required by a paper received from the Office.

C. To the best of the undersigned attorney's information and belief, the Notice was not received at Intuitive Surgical, Inc. The undersigned attorney has searched the legal department mail receptacle in the mail room and the surrounding area (e.g., under the receptacle shelves in case the Notice had somehow fallen), the shelf area in which the paper record associated with this application is kept, and the contents the paper record associated with this application but was unable to find the Notice.

D. To the best of the undersigned attorney's information and belief, the legal department first learned that the Notice had been mailed when the legal department received a Notice of

Abandonment that the Office appears to have mailed on 19 February 2010. Upon receipt of this Notice of Abandonment, Anne Killingsworth accessed the Office's Patent Application Information Retrieval system and was able to download a copy of the Notice of Non-Compliant Amendment.

E. To the best of the undersigned attorney's information and belief, the docketing system does not provide a "master docket for the firm" for a particular date range in any usable form. In lieu of such a "master docket", attached to this Petition as Exhibit 1 are (i) an image of the portion of the docketing system record that is associated with this application's identifying details, and (ii) two images that show the portion of the docketing system record that is associated with this application's due dates (completed and pending). These images indicate that the due date associated with the Notice was not entered into the legal department's docketing system, and they are submitted as further evidence that the Notice was not received. The images show that some portion of the record associated with this application was updated on 24 November 2009, but again, there is no evidence that any due date associated with the Notice was entered. After discussing this matter with Anne Killingsworth, the undersigned attorney was unable to determine what portion, if any, of this record was updated on 24 November 2009.

III.

Applicant respectfully petitions the Director under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment. Accordingly, Applicant believes that no petition fee is due.

If, however, the Office determines that this Petition is more correctly made under 37 C.F.R. § 1.137(a) or 1.137(b), then to speed handling of this Petition the Office is authorized to deduct from Deposit Account No. 503404 \$540.00 (for § 1.137(a)) or \$1620.00 (for § 1.137(b)) as may be necessary.

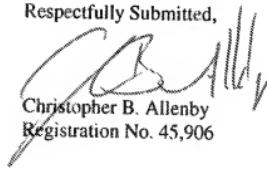
In addition, the Office is authorized to deduct from Deposit Account No. 503404 any additional fees that may be due to reopen prosecution of this application. Large entity fees apply.

IV.

Applicant includes with this Petition a corrected version of the amendment paper filed 7 October 2009. This corrected version includes the correct claim status identifiers for all claims.

Applicant respectfully requests the Director grant this petition. Please contact the undersigned attorney at 408-523-2460 if there are any questions.

Respectfully Submitted,



Christopher B. Allenby
Registration No. 45,906

Exhibit I

Docket System Images

This is the "Patent Details" page from the assignee's DIAMS record that is associated with this application:

DIAMS

File Main Menu Reports Utilities Research Windows Help

DIAMS - Patent Management (View only)

Docket ID: ENDO001/JUS

Short Title: CANNAVA SYSTEM & METHOD OF USE

KANNABA SYSTEM & METHOD OF USE
Client/Business Units

Attorneys: ALLENBY CHRISTOPHER

Other Party: [Redacted]

Cost Centers: [Redacted]

Inventors: VARGAS JAIME S

Laboratories: [Redacted]

Related Matters: [Redacted]

Invention Disclosure Disclosure 2 Prior Art Names Patent Details Additional Info Docs Link Docketing

Country: United States Convention: Ptl. Claimed Type: Patent Application No: 10/661,159 Application Date: 12-Sep-2003

Region: Origin: Sub Type: Grant No: Grant Date: [Redacted]

Status: Pending Request Search Date: 1st Publication No: 2004-0064322 1st Publication Date: 18-Mar-2004

Sub Status: Dep. Multi Dep. Request Exam. Date: 2nd Publication No: [Redacted] 2nd Publication Date: [Redacted]

Published: [Redacted]

Claimed Priorities & Parent Records

Priority: ENDO001/PCT/US 12-Sep-2002

File Status: Abandoned Date: 06-Aug-2007 Expiration Date: 12-Sep-2023

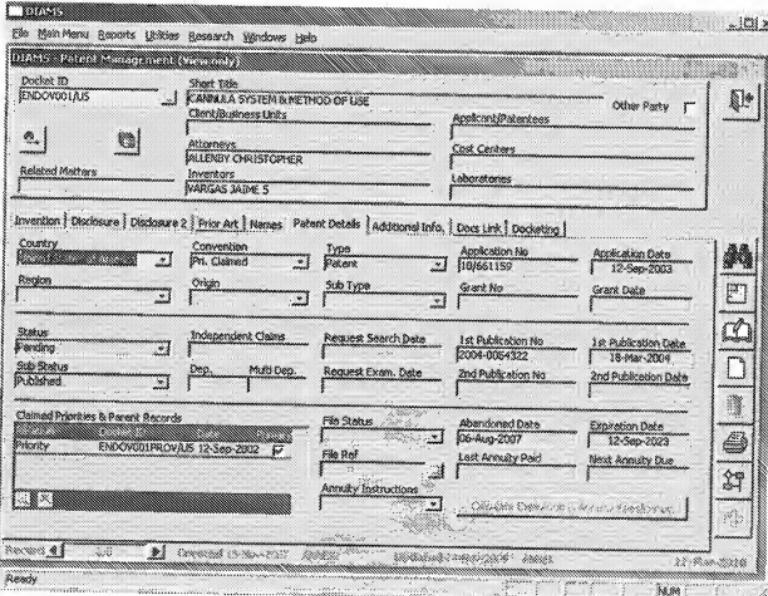
File Ref: Last Annuity Paid: [Redacted] Next Annuity Due: [Redacted]

Annuity Instructions: [Redacted]

Office: USPTO - Washington, DC

Record 4 of 40 Generated 12-Jun-2012 10:45:22 10:45:22 10:45:22 10:45:22 10:45:22 10:45:22

Ready NUM



This is the first of two images that show docket entries (due and completed) currently in the DIAMS system that are associated with this application. Note that the current assignee purchased this application after it had been filed and prosecution begun, and so not all docket entries associated with the full history of this application are shown. Note also that although this record was last updated on 24 November 2009 (the update information appears near the bottom of the image), no docket entry appears for the Notice of Noncompliant Amendment.

DIAMS

File Main Menu Reports Utilities Research Windows Help

DIAMS - Patent Application (View Only)

Docket ID: 10/661,159

Short Title: CARBON SYSTEM & METHOD OF USE

Client/Business Units:

Attorneys: ALLENBY CHRISTOPHER

Applicant/Patentees:

Inventors: VARGAS JAIME S

Other Party:

Cost Centers:

Laboratories:

Related Matters:

Invention | Disclosure | Disclosure 2 | Prior Art | Names | Patent Details | Additional Info. | Docs Link | Docketing

Phase: NYF

Pending Grant All Events To Do Done

Subphase: From: To:

Date	Event	From	To
10/661,159	Application Date	12-Sep-2003	15-Nov-2007
2004-005432	Pub First	18-Mar-2004	20-Oct-2009
	DAI Mail Date	17-Feb-2006	15-Nov-2007
	Final DA Mail Date	01-Nov-2006	15-Nov-2007
	ADVISOR OPINION	21-Feb-2007	15-Nov-2007
	Abandoned Date	06-Aug-2007	15-Nov-2007
	Restriction Requirement Mail Date	29-Oct-2008	04-Nov-2008
	IDS VERT & ATTY	15-Nov-2008	17-Nov-2008
	IDS atty	16-Dec-2008	17-Dec-2008
	not	29-Dec-2008	06-Dec-2009
	CA2 Mail Date	07-Apr-2009	09-Apr-2009
	Expiration Date	12-May-2023	15-Nov-2007
	DAI Response Due	17-May-2006	42491
	Final Docket Date + 2 Dmgs	17-Jun-2006	15-Nov-2007
	Final Docket Date + 3 Dmgs	17-Jul-2006	

Record 4 of 10 Updated 10-Jun-2009 10:00 AM by [REDACTED] Updated 24-Nov-2009 10:00 AM by [REDACTED] 22-Nov-2009

Ready

NLM

This is the second of two pages that show docket entries (due and completed) currently in the DIAMS system that are associated with this application.

DIAMS

File Main Menu Reports Utilities Research Windows Help

DIAMS - Patent Management (View only)

Docket ID: ENDO0001US Short Title: CANULLA SYSTEM & METHOD OF USE
Client/Business Units:

Attorneys: ALLENBY CHRISTOPHER
Inventors: VARGAS JAIME S

Other Party: Applicant/Patentees
 Other Party
Code Centers:
Labs:

Related Matters:

Invention Disclosure Prior Art Names Patent Details Additional Info Docs Link Declining

Phase: NWP Pending Grant All Events Subphase From To To Do Done

Date	Event	Subphase	From	To
ext			29-Dec-2006	05-Dec-2006
OAI2 Mail Date			07-Apr-2009	09-Apr-2009
Expiration Date			12-Sep-2023	15-Nov-2007
OAI Response Due	17-May-2006	13-Aug-2006	42491	15-Nov-2007
Final Resp. Due - 2 Mo Ext	01-Dec-2006			15-Nov-2007
Final Resp. Due - 1 Mo Ext	01-Jan-2007			15-Nov-2007
Response to Previous Advisory Action	01-Jan-2007	30-Jan-2007	42491	15-Nov-2007
Final Response Due	01-Feb-2007			15-Nov-2007
Final Resp. Due - 2 Mo Ext	01-Mar-2007			15-Nov-2007
Final Resp. Due - 1 Mo Ext	01-Apr-2007			15-Nov-2007
Final Resp. Inst. of Appeal Due - FINA	01-May-2007			15-Nov-2007
Restriction Requirement Resp. Due	29-Nov-2008	12-Nov-2008	42491	04-Nov-2008
OAI2 Response Due	07-Jul-2009	07-Oct-2009	42491	09-Apr-2009

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Record 4 | 2/8 | Created 15-Nov-2007 ANXEX Updated 24-Nov-2008 42491 | 22-Nov-2008 30915 | JNLN

Ready

***** Last Item *****

Supplement to Exhibit I

This supplement enlarges the docket system images in the petition filed 24 March 2010.

Applicant believes these enlarged images are legible and suitable for consideration.

This is the "Patent Details" page from the assignee's DIAMS record that is associated with this application:

DIAMS

File Main Menu Reports Utilities Research Windows Help

Patents - Patent Details - Search This (View only)

Docket ID: EPICW0011AUS

Short Title: CANULA SYSTEM & METHOD OF USE
Class/Classification Units:
Authors: KILLEEN CHRISTOPHER
Inventors: VARGAS JUAN S

Related Matters:

Additional Info:

Country	Convention	Type	Application No.	Publication Date
United States of America	PCT Claimed	Patent	10/661,159	12-Sep-2003
Region	Other	Sub Type	Grant No.	Grant Date

Status:

Priority	Request Search Date	1st Publication No.	Last Publication Date
10/661,159	12-Mar-2004	2010-015322	18-Mar-2004
Sub Status	Multi Dep.	Request Exam. Date	2nd Publication No.
Published	1		

Claimed Priorities & Parent Records:

Priority	Abandon Date	Examination Date
EPICW0011AUS 12-Mar-2002	25-Aug-2007	12-Sep-2003
EPICW0011AUS 12-Mar-2002	Last Amenity Paid	Next Amenity Date

Amendments:

Amendment	Comments	Date Filed	Date Received	Date Entered	Date Entered By	Date Entered To	Date Entered By
1							

Comments:

Entered: 28-CR-2007 Action: Ready Date: 26-May-2009 Action: Ready Date: 26-May-2010

This is the first of two images that show docket entries (due and completed) currently in the DIAMS system that are associated with this application. Note that the current assignee purchased this application after it had been filed and prosecution begun, and so not all docket entries associated with the full history of this application are shown. Note also that although this record was last updated on 24 November 2009 (the update information appears near the bottom of the image), no docket entry appears for the Notice of Noncompliant Amendment.

The screenshot shows the DIAMS software interface with the following details:

- Header:** DIAMS, Patent Application System (Windows only)
- Menu Bar:** File, Main Menu, Reports, Listings, Research, Windows, Help
- Toolbar:** Back, Forward, Stop, Refresh, Home, Print, Copy, Paste, Find, Save, Open, New, Exit.
- Left Panel:**
 - Docket ID: END000115
 - Short Title: CANADA SYSTEM & METHOD OF USE
 - Client/Business Units: [redacted]
 - Attorneys:
 - ALBERT CHRISTOPHER
 - Inventors:
 - VARGAS JAMES S
 - Rebeldia Matters
- Central View:** A table showing patent details.

Phase	✓ NPF	✓ Pending	✓ Grant	✓ All	✓ Events	✓ To Do	✓ Done	Subphase	From	To
Application Date		10/06/1159						12-Sep-2003		
Publ. First				2004/005432				18-Mar-2004		
Off.1 Mail Date								17-Feb-2005		
Final Off. Mail Date								01-Nov-2005		
ADVISOR OPINION								21-Feb-2007		
Abandoned Date								06-Aug-2007		
Restriction Requirement Mail Date								29-Oct-2008		
DS VERT & ATTY								12-Nov-2008		
Its. apply.								17-Nov-2008		
ext.								12-Dec-2008		
O/A2 Mail Date								29-Dec-2008		
Expiration Date								09-Apr-2009		
CA1 Response Due								12-Sep-2009		
First Search Due - 2 days from								17-May-2006	13-Aug-2006	42991
First Search Due - 3 days from								01-Oct-2006		15-Nov-2007
First Search Due - 4 days from										15-Nov-2007
- Bottom Status Bar:** Ready

This is the second of two pages that show docket entries (due and completed) currently in the DIAMS system that are associated with this application.

DIAMS - Patent - Search - Input (List only)

Docket ID: END0001/US

Short Title: FANNIA A SYSTEM & METHOD OF USE
Client Business Links

Attorneys: ALLEN/B CHRISTOPHER

Inventors: VARGAS, JAIINE S

Related Matters:

Invention | Disclosure | Disclosure 2 | Prior Art | Names | Parent Details | Additional Info | Docs Link | Docketing

Phase	NYF	Pending	Grant	All	Events	To Do	Done	Subphase	From	To
Ex2										
Case Rec'd Date	05/05/2006							29-Dec-2008	05-Dec-2008	
Case Rec'd Status	Examination Initiated							07-Apr-2009	09-Apr-2009	
Patent Request Date								12-Sep-2003	15-Nov-2007	
Patent Request Date - 2nd Request								17-May-2006	13-Aug-2006	
Printed Record	Date - 1	No Record						01-Dec-2006		
Printed Record	Date - 1	No Record						01-Jan-2007		
Printed Record for Pending Application										
Print Response Date								01-Jan-2007	30-Jan-2007	
Print Resp	Date - 1	No Recd						01-Feb-2007		
Print Resp	Date - 2	No Recd						01-Mar-2007		
Print Response Date - Assignment Date - Filing								01-Apr-2007		
Reception Requirement Response Date								29-Nov-2009	12-Nov-2009	
Office Response Date								07-Jul-2009	07-Oct-2009	
Received	25	25	25	25	25	25	25	25	25	25
Ready										

Received 25 Jun 2009 09:55:05 EDT Updated 24-Nov-2009 14:45:15 EDT 23-Apr-2013 15:15:15 EDT